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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,464	12/23/2004	Mitsuo Najima	SIP008	2676

7590 07/27/2006

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EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/519,464

Applicant(s)

NAJIMA ET AL.

Examiner

Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892),
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al U.S. Patent 6,861,471.

The rejection was set in the office action at pages 2-4 of the office action mailed on 02/22/2006 and it is incorporated here by reference.

Response to Arguments

4. Applicant's arguments filed 05/22/2006 have been fully considered but they are not persuasive. The argument is that Masuda discloses a multi-step process, whereas in the present claims an acid-modified chlorinated polyolefin resin is grafted with a monomer mixture containing a (meth)acrylate ester monomer having one hydroxyl group and another vinyl monomer. Although Masuda discloses two stages for grafting: first grafting with a (meth)acrylic ester having one hydroxyl group, and a second=subsequent step a (meth)acrylic acid monomer is added, Masuda clearly discloses the esterification step by employing (meth)acrylic ester having at least one hydroxyl group and a subsequent step of a grafting of (meth)acrylic acid monomer. The graft copolymerization can be obtained in one step in the absence of unexpected

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results. There is no benefit of using a mixture of the monomers for a graft-copolymerization in a single step. Masuda discloses the same starting acrylic modified chlorinated polyolefin resin and the same grafting monomers. A solvent for graft polymerization in Masuda invention can be selected such as tetrahydrofuran since any cyclic ether compound works within the same expectation. Independent claim 4 is a product-by-process. Claimed product-by-process is a product. The patentability of a product does not depend on its method of production. The claimed product appears to be same or similar to that of the prior art, although produced by a different process. See *In re Marosi*, 218 USPQ 289, 292 (Fed.Cir. 1983). There is no characteristic of an acrylic-modified chlorinated polyolefin resin obtained by a method in the independent claim 1, nor for a resin composition in the independent claim 4. Case law holds that while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed.Cir. 1993).

There is no Attorney signature in the Remarks of 05/22/2006.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al U.S. Patent 6,861,471 in view of JP 11-189696 (cited by applicants).

As discussed above, Masuda does not disclose a graft-copolymerization of a monomer mixture with an acid-modified chlorinated polyolefin in one step.

JP 11-189696 (here is now JP'696) discloses carboxylated chlorinated polyolefin (A) grafted with (meth)acrylic acid monomer (B) and monomer (C) having (meth)acrylic ester and a hydroxyl group in the molecule, Abstract.

It would have been obvious to one of ordinary skill in the art to use a mixture of monomers as teaching by JP'696 for graft-copolymerizing an acid-modified chlorinated polyolefin resin in Masuda invention since both reference disclose similar resulting graft copolymerization of a carboxylated, chlorinated polyolefin product, and thus it would have been expected to provide adequate results. There is no showing of unexpected results derived from said use.

In light of the new rejection of claims 1-5 under 103 (a) over Masuda in view of JP'696, this action is not final.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.A.


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

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